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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,509	07/17/2000	FUMITAKE YODO	6715/60188	7100

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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.
09/600,509

Applicant(s)
Fumitake Yodo

Examiner
Andrew J. Fischer

Art Unit
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 23, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Acknowledgments

1. The amendment filed April 23, 2002 (Paper No. 5) is acknowledged. Accordingly, claims 1 and 3-7 remain pending.
2. Applicant's election without traverse of Invention I (claims 1-7) in Paper No. 5 is acknowledged.
3. The substitute specification filed with the amendment on April 23, 2002 has been entered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

5. Claims 1 and 3-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

- a. In claim 1, it is unclear if the "external source is external to the terminal device claimed or external to the second memory.
- b. In claim 3, it still is unclear whether the Applicant is claiming the subcombination of a terminal device or the combination of a terminal device and an account center since Applicant recites "wherein the accounting processing status is transmitted from the accounting

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center to the terminal device.” If the accounting processing status was transmitted from a place other than the accounting center, would the reference read on Applicant’s claim?

If the Applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the Applicant intends to claim the combination, the preambles of the claims must be amended to be consistent with the language in the body of the claim. Applicant(s) are reminded that shift is generally not permitted. See MPEP §819.

It is the Examiner’s primary position that the limitations “wherein the accounting processing status is transmitted from the accounting center to the terminal device” are functional limitations which are given little patentable weight thereby placing any such positive structural limitations found within this phrase to be outside the claim’s scope. In addition to the above, if Applicant(s) concur with the Examiner’s position, the Examiner respectfully requests Applicant(s) to explicitly state their concurrence on the record. Upon receiving such concurrence, the 35 U.S.C. §112 second paragraph rejection will then be withdrawn.

Alternatively, if Applicant(s) argue that the limitation should be given greater patentable weight requiring the Examiner to show the prior art having such structural features, the 35 U.S.C. §112 second paragraph rejection will be maintained.

c. In claim 4, the phrase “wherein the accounting point information stored in the first memory is insufficient for the received information” is indefinite and unclear. It is not known how the information can be “insufficient.”

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d. In claim 6, it is unclear whether the Applicant is claiming the subcombination of a terminal device or the combination of a terminal device and an account center since Applicant recites “an external device having a third memory.”

If the Applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the Applicant intends to claim the combination, the preambles of the claims must be amended to be consistent with the language in the body of the claim. Applicant(s) are reminded that shift is generally not permitted. See MPEP §819.

It is the Examiner's primary position that the limitations “an external device having a third memory” are functional limitations which are given little patentable weight thereby placing any such positive structural limitations found within this phrase to be outside the claim's scope. In addition to the above, if Applicant(s) concur with the Examiner's position, the Examiner respectfully requests Applicant(s) to explicitly state their concurrence on the record. Upon receiving such concurrence, the 35 U.S.C. §112 second paragraph rejection will then be withdrawn.

Alternatively, if Applicant(s) argue that the limitation should be given greater patentable weight requiring the Examiner to show the prior art having such structural features, the 35 U.S.C. §112 second paragraph rejection will be maintained.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

7. Claims 1, 4, and 6, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Boccon-Gibod et. al. (U.S. 2001/0016836 A1). Boccon-Gibod et. al. discloses the following: first and second memory storing both content data and accounting data (memory registers with the client system; the second data could be a password); a controller (the CPU); wherein the received information (the password is confirmed) is stored in the second memory, the controller modifies the accounting point information stored in the first memory and updates the attributes (removes the password lock) from an unavailable state to an available state.

8. Claims 1, 4, and 6, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kleiman (U.S. 5,959,945).

9. Functional recitation(s) using the word “for” (e.g. “for” as recited in claim 1) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

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patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). By way of examples only the Examiner suggests, “a first memory storing accounting point information,” “a second memory storing,” and “a controller updating” as positive recitations removing the language from its currently functional domain.

10. For due process purposes, the Examiner notes Applicant has declined the Examiner’s express invitation¹ to indicate and define claim limitations to have a meaning other than their ordinary and accustom meaning. Therefore, for ex parte examination, the presumption in favor of the ordinary and accustom meaning is maintained and the claims are interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).² The Examiner will henceforth rely on this interpretation.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

¹ See the Examiner’s previous Office Action, Paper No. 4, Paragraph No. 12.

² See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 4, and 6, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Russo (U.S. 5,619,247). Russo discloses the claimed invention except that the content is video instead of Applicant's claimed audio.

However, the missing elements (i.e. the audio limitations) are only found in the nonfunctional descriptive material and are not functionally involved in the claimed apparatus (i.e. Applicant's claimed invention is in no way dependent upon the content of the audio or the content of the information transferred to the user).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the content of Russo with any type of content. The descriptive material will not distinguish the claimed invention over the prior art in terms of patentability because the data does not functionally relate to the steps in the method. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowery*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Allowable Subject Matter

13. Claims 3, 5, and 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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Response to Arguments

14. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive.

15. Regarding the combination/subcombination, the Examiner notes that only items of the "terminal device" must be positively recited within the claims.

16. While Applicant argues the differences between his invention and the references, the claims nevertheless are still anticipated and obvious based upon the Examiner's broadest reasonable interpretation of the claimed elements.

17. Because Applicant has deliberately removed all instances of "means for" from the claims and in accordance with the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th*³ ("Guidelines"), it is the Examiner's position that Applicant has expressly intended not to invoke 35 U.S.C. 112 6th paragraph.⁴ Therefore, the Examiner has interpreted the claims so as to NOT invoke 35 U.S.C. 112 6th paragraph.⁵

³ Federal Register Vol 65, No 120, June 21, 2000.

⁴ Note that statements made during prosecution commit the inventor to a particular meaning of a claim term. See e.g. *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1158, 42 USPQ2d 1577, 1585 (Fed. Cir. 1997).

⁵ Because prong one is not met, the Examiner makes no findings regarding prongs two and three in the Guidelines. Along the same lines of reasoning, the Examiner makes no findings on whether there are "purely functional terms, without the additional recital of structure" as in *Al-*

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Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

Site Corp. v. VSI International Inc., 50 USPQ2d at 1167. However, it is the Examiner's position that even if a determination of these two factors would be in the affirmative—which would help support a rebuttal of the presumption that 112 6th paragraph is not invoked (i.e. would lean *towards* invoking 112 6th paragraph)—Applicant's express intent not to invoke must outweigh these two factors as a matter of law. To hold otherwise would be unprecedented since claim limitations, when not repugnant to their usual meaning, have never been interpreted as going against Applicant's clear, express intention. The Examiner notes that while using the prosecution history to determine invocation is not new (e.g., *Cole v. Kimberly-Clark Corp.*, 102 F.3d at 524, 531, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996), noting that whether 112 6th paragraph is invoked involves an analysis of the "patent and prosecution history"), its weight within the present context is currently undecided.


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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

20. The art unit and technology center for this application has changed. The new art unit is 3627 in technology center 3600. So that papers may be properly matched, please indicated the new art unit on any paper submitted with this application.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292. If the points in this Office Action are in anyway unclear, the Examiner would be more than welcome to discuss this Office Action in a telephone call.


ANDREW J. FISCHER
PATENT EXAMINER


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AJF
May 18, 2002